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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/966,313	Applicant(s) ENTWISTLE, PAUL	
	Examiner Etienne P LeRoux	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Claims Status

Claims 1-18 are pending. Claims 1-18 are rejected as detailed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites "assessing each location in relation to specified attributes including attributes of documents already stored at said location." The specification does not contain a clear and concise written description of the process of determining "specified attributes." For the purposes of this Office Action "specified attributes" will be interpreted as an attribute associated with a storage location. Furthermore, the specification does not contain a clear and concise written description of the process of a previous storing of documents at each location such that attributes of the documents can be determined. It appears storage locations are assessed based on a previous random storage of documents and thus the skilled artisan would conclude that there is no distinguishable difference between the storage locations.

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Claim 1 recites “allocating a weighting value to each storage location with respect to other storage locations and in relation to specified attributes.” The specification does not contain a clear and concise written description of the manner and process of determining a “weighting value.” For purposes of this Office Action, “weighting value” will be interpreted as a ranking of storage locations based on the attributes of the documents in such storage locations.

Claim 1 recites “comparing that at least one attribute of the document with the attributes and weighted values of said storage locations.” The specification does not contain a clear and concise written description of determining a weighted value of the document such that the document can be compared with a weighted value of a storage location.

Claims 2-14 are rejected for being dependent from a rejected base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “assessing each location in relation to specified attributes including attributes of documents already stored at said location, and allocating a weighting factor to each storage location with respect to other storage locations and in relation to specified attributes.” The scope of the invention is unclear because the relevance of “specified attributes” with respect to the storage locations and the documents already stored at the location is not easy to determine. In particular, above limitation includes two instances of “specified attributes.” It is unclear

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whether the “specified attributes” are the same or different. For purposes of this Office Action, “specified attributes” will be assumed comparable to attributes of the documents.

Claim 1 recites “comparing the at least one attribute of the document with the attributes and weighted values of said storage locations.” The scope of the invention cannot be determined because it is unclear to which attribute, i.e., the specified attributes or the attributes of documents already in storage locations, the received document is being compared. For purposes of this Office Action, it will be assumed that “one attribute” is comparable to “specified attribute.”

Claims 2-14 are rejected for being dependent from a rejected base claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter for the following reasons:

MPEP § 2106 states:

Claims to computer-related inventions that are clearly non-statutory fall into the same general categories as non-statutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute descriptive material. Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable.

A process that merely manipulates an abstract idea or performs a purely a purely mathematical algorithm is non-statutory despite the fact that it might inherently have some usefulness. In *re Sarkar*, 588 F.2d at 1335, 200 USPQ at 139.

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Descriptive material can be characterized as either functional descriptive material or non-functional descriptive material. In this context, functional descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component. When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely, claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978).

- 1) The preamble of claim 1 includes “a method of storage of electronic documents characterized in that said method includes the steps of.” The method steps following the preamble are not functional descriptive material recorded on computer-readable medium. The method steps are not statutory because technology is not required to permit the function of the method steps to be realized.
- 2) Claim 1 recites “assessing each location and allocating a weighting value to each location.” Assessing and allocating are mental processes for manipulating abstract ideas. Such contemplations do not impart functionality to a technological element such as a computer component.
- 3) The claim 1 limitation “assessing at least one attribute of the document” is a mental process which is mere manipulation of an abstract idea. Such a mental process is not directed to a functioning computer component.
- 4) The claim 1 limitation “selecting to locate the electronic document” is an abstract idea and is unrelated to the method of storing an electronic document as included in the preamble.

Examiner notes claim 1 covers the elements included in claim 15 and thus claim 15 is rejected for reasons similar to the above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 6-8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 5,222,234 to Wang et al (hereafter Wang) and further in view of US Pat No 5,995,094 to Eggen et al (hereafter Eggen), as best examiner is able to ascertain.

Claim 1:

Wang discloses:

- compiling a list [LADN, col 4, lines 1-5 because it lists every document in every folder, it must also list the folders] of possible storage locations for the documents [pointer entry, col 4, lines 1-5] within a document storage system, each storage location capable of storing a plurality of documents [folder documents, col 3, line 68 – col 4, line 5]
- assessing [document relational object, col 3, lines 64-67] each location in relation to specified attributes including attributes of documents already stored at said location
- upon receipt of an electronic document, assessing at least one attribute of the document [library server 18, col 3, lines 15-20]

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- with reference to the attributes of the selectable locations for storage, selecting to locate said electronic document in at least one of the storage locations [Fig 2, 46].
- storing said electronic document in at least one of the storage locations [Fig 2, 46]

Wang discloses the claimed elements as noted above but fails to disclose comparing the at least one attribute of the document with the attributes and weighted values of said storage locations. Eggen discloses comparing the at least one attribute of the document with the attributes and weighted values of said storage locations [Fig 2, col 5, lines 5-25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wang to include comparing the at least one attribute of the document with the attributes and weighted values of said storage locations as taught by Eggen for the purpose of assigning a user preference to stored data, i.e., a music track on a CD. The skilled artisan would have been motivated to improve the invention of Wang per the above such that a user can implement a sequential choice amongst the items that is both meaningful in view of the user's preferences [col 1, lines 45-50].

Claim 2:

Wang discloses wherein for each incoming document, a correlation is made against a database representative of the filing properties of the storage location of the filing system which is being used to store the document [col 4, lines 25-40]

Claim 3:

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Wang discloses a certain number of the storage locations with the strongest correlation values are presented for selection upon receipt of a document [search criteria document is reusable, col 2, lines 15-20]

Claim 4:

Wang discloses if a correlation is matched for an incoming document, that document is stored in the matching storage location automatically [Fig 2, 46]

Claim 5:

The combination of Wang and Eggen discloses the elements of claims 1 and 3 as noted above. Official Notice is taken that upon analysis of an incoming document, a matching correlation is not identified such that none of the presented storage locations are relevant, the incoming document is stored in a storage location using a conventional method of document filing is well-known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Wang and Eggen to include upon analysis of an incoming document, a matching correlation is not identified such that none of the presented storage locations are relevant, the incoming document is stored in a storage location using a conventional method of document filing for the purpose of providing an initial storage for receiving the document.

Claim 6:

Wang discloses as new documents are added into the filing system, the database of filing properties used for the correlation and analysis of storage locations is adapted to reflect the characteristics of the documents received [col 2, lines 10-20]

Claim 7:

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Wang discloses the method used is adaptive to reflect the characteristics of received documents [col 3, lines 15-20]

Claim 8:

Wang discloses the storage location assessment occurs upon receipt of each new document [col 3, line 64 – col 4, line 5]

Claim 10:

Wang discloses the attributes of the storage locations which are assessed are predefined by the system and/or the user [col 3, line 64 – col 4, line 5]

Claim 11:

Eggen discloses statistical significance values are assigned to the selected attributes [Fig 2, col 5, lines 5-25].

Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Wang and Eggen and further in view of US Pat No 5,915,251 to Burrows et al (hereafter Burrows), as best examiner is able to ascertain.

Claim 14:

The combination of Wang and Eggen disclose the elements of claim 1 as noted above. The combination of Wang and Eggen fails to disclose the electronic documents received are e-mails. Burrows discloses the electronic documents received are e-mails [col 6, lines 44-48]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to

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modify the combination of Wang and Eggen to include the electronic documents received are e-mails as taught by Burrows for the purpose of providing a means for personal document storage. The skilled artisan would have been motivated to improve the invention of Wang and Eggen per the above such that the commercialization of the invention can be extended by including the very popular electronic mail system.

Claim 15:

Wang discloses:

- compiling a list of possible storage locations for the documents [pointer entry, col 4, lines 1-5] within a document storage system, each storage location capable of storing a plurality of documents [folder documents col 3, line 68 – col 4, line 5]
- assessing [document relational object, col 3, lines 64-67] each location is relation to specified attributes including attributes of documents already stored at said location and allocating a weighting value to each storage location with respect to other storage locations and in relation to specified attributes
- upon receipt of an electronic document, assessing at least one attribute of the document [col 3, lines 16-19],
- with reference to the attributes of the selectable locations for storage, selecting to locate said electronic document in at least one of the storage locations [Fig 2, 46].
- storing said electronic document in at least one of the storage locations [Fig 2, 46]

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Wang discloses the claimed elements as noted above. Wang fails to disclose comparing the at least one attribute of the document with the attributes and weighted values of said storage locations. Eggen discloses comparing the at least one attribute of the document with the attributes and weighted values of said storage locations [Fig 2, col 5, lines 5-25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wang to include comparing the at least one attribute of the document with the attributes and weighted values of said storage locations as taught by Eggen for the purpose of assigning a user preference to stored data, i.e., a music track on a CD. The skilled artisan would have been motivated to improve the invention of Wang per the above such that a user can implement a sequential choice amongst the items that is both meaningful in view of the user's preferences [col 1, lines 45-50].

The combination of Wang and Eggen disclose the elements of claim 1 as noted above. The combination of Wang and Eggen fails to disclose the electronic documents received are e-mails. Burrows discloses the electronic documents received are e-mails [col 6, lines 44-48]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Wang and Eggen to include the electronic documents received are e-mails as taught by Burrows for the purpose of providing a means for personal document storage. The skilled artisan would have been motivated to improve the invention of Wang and Eggen per the above such that the commercialization of the invention can be extended by including the very popular electronic mail system.

Claim 16:

The combination of Wang, Eggen and Burrows discloses the elements of claim 15 as noted above. Furthermore, Burrows discloses the received e-mail can be selected to be stored in more than one storage location [col 5, line 62 through col 6, line 6].

Claim 17:

The combination of Wang, Eggen and Burrows the elements of claim 15 as noted above. Furthermore, Burrows discloses the weighting values and/or attributes are reviewed and if necessary revised as new e-mails are received and stored [col 6, lines 12-14].

Claim 18:

The combination of Wang, Eggen and Burrows discloses the elements of claim 15 as noted above. Burrows fails to disclose the attributes and weighting values are stored in a companion database with which the attributes of the received e-mail is compared rather than the actual content of each of the storage locations.

Burrows discloses the attributes and weighting values are stored [Fig 3 and col 5, lines 61-66].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burrows to include the attributes and weighting values are stored in a companion database with which the attributes of the received e-mail is compared rather than the actual content of each of the storage locations.

The ordinarily skilled artisan would have been motivated to modify Burrows per the above for the purpose of separating the storage elements.

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Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Wang and Eggen and further in view of US Pat No 6,189,001 to McGovern et al (hereafter McGovern), as best examiner is able to ascertain.

Claim 9:

The combination of Wang and Eggen discloses the elements of claims 1, 7 and 8 as noted above. The combination of Wang and Eggen fails to disclose the storage location assessment occurs at regular time intervals. McGovern discloses the storage location assessment occurs at regular time intervals [col 7, lines 36-47]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burrows to include the storage location assessment occurs at regular time intervals as taught by McGovern. The ordinarily skilled artisan would have been motivated to modify the combination of Wang and Eggen per the above for the purpose of re-assessing the storage level assigned to the object [McGovern col 7, line 36].

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Wang and Eggen and further in view of US Pat No 6,212,517 to Sato et al (hereafter Sato), as best examiner is able to ascertain.

Claim 12:

The combination of Wang and Eggen discloses the elements of claim 1 as noted above:

The combination of Wang and Eggen fails to disclose a companion database associated with the storage structure is provided, said database including statistically differentiating key words associated with particular storage locations and only these keywords are used in the correlation of the attributes of the incoming document and the available storage locations. Sato

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discloses keywords are classified by attributes or statistical information [col 12, lines 35-54]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Wang and Eggen to include a companion database associated with the storage structure is provided, said database including statistically differentiating key words associated with particular storage locations and only these keywords are used in the correlation of the attributes of the incoming document and the available storage locations. The ordinarily skilled artisan would have been motivated to modify the combination of Wang and Eggen per the above for the purpose of assisting the user by simplifying the display [Sato, col 12 line 35-40].

Claim 13:

The combination of Wang and Eggen discloses the elements of claims 1 and 12 as noted above. The combination of Wang and Eggen fails to disclose the correlation and selection of the storage location for the incoming document is made with respect to the information for the storage locations in the companion database rather than the actual contents of the documents stored in the storage locations. However, Sato discloses keywords are classified by attributes or statistical information [col 12, lines 35-54]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Burrows and Sato to include the correlation and selection of the storage location for the incoming document is made with respect to the information for the storage locations in the companion database rather than the actual contents of the documents stored in the storage locations. The ordinarily skilled artisan would have been motivated to modify the combination of Wang and Eggen for the purpose of assisting the user by simplifying the display [Sato, col 12 line 35-40].

Response to Arguments

Applicant's arguments filed 7/15/2004 have been fully considered and found partially persuasive based on applicant's current amending of the claims.

Applicant Argues:

Applicant states in the seventh paragraph of page 6 "United States Patent No 5,915,251 to Burrows et al discloses an indexing system that is no more than the hierarchical indexing structure mentioned in the preamble of the Applicant's application. The '251 Burrows et al system is extremely complex: each word within a document is given two values, which uses large amounts of processing and storage memory. When a document is added or removed from the '251 Burrows et al system, the entire indexing system needs to be updated. This is clearly impractical. Applicant's application avoids his problem by giving values to the locations in which the documents are stored, thereby allowing groups of related documents to be stored in the same storage location. There is no teaching in '251 Burrows et al patent of storing a plurality of documents in a particular storage location as a result of a correlation of attributes of the documents and the location itself. Therefore, Applicant sincerely believes that currently amended independent claims 1 and 15, with dependent claims 2-14 and 16-18 are novel over the Burrows et al '251 patent.

Examiner Responds:

Examiner is not persuaded. Without acquiescing with applicant, examiner provides supra new art rejection in order to reduce arguing about what comprises "a storage location capable of storing a plurality of documents." In above rejection over Wang, examiner maintains Wang's folder which contains other documents reads on the above claim limitation.

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Applicant Argues:

Applicant states in the second paragraph on page 7 “In addition, the ‘251 patent to Burrows et al discloses an indexing system that uses both literal and numerical indexing values in the same database. Each record to be indexed is given a literal value and a numerical value and each record value is stored in the database. Values within specified ranges can then be located by a user. Also, in the ‘251 Burrows et al patent each document/record is given a value rather than the storage location in which the record/document is to be located, as in Applicant’s invention. Thus, the ‘251 Burrows system makes no comparison between attributes of incoming documents and attributes and weighting values of storage locations, nor does it weight one storage location relative to another storage location with respect to specified attributes to allow the best storage location for an incoming document to be determined.”

Examiner Responds:

Examiner is partially persuaded. Without acquiescing with applicant, examiner provides supra new art rejection in order to advance prosecution by reducing arguing about what comprises above claim limitations. Examiner clearly points out in supra Office Action how Wang in view of Eggen reads on above claim limitations.

Applicant Argues:

Applicant states in the third paragraph on page 7 “Further, the locations disclosed in ‘251 patent are not capable of storing a plurality of documents as in the present invention. Thus applicant believes that the ‘251 patent to Burrows et al does not destroy the novelty of currently amended claims 1 and 15 and respectfully requests reconsideration of the rejection.

Examiner Responds:

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Examiner is not persuaded. Examiner maintains above statement by applicant is merely opinion because no reference is provided to the Burrows' teaching. Examiner maintains that in the Burrows disclosure it is possible to store a plurality of documents.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

11/30/2004



SAFET METJAHIC
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